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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,156

10/28/2003

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EXAMINER

OBEID, FAHD A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/696,156	<b>Applicant(s)</b> KAHLON ET AL.	
	<b>Examiner</b> FAHD A. OBEID	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/19/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/19/2009 has been entered.

#### ***Preliminary Remarks***

2. This is in reply to application filed on 05/19/2009.
3. Claims 25-32 remain cancelled.
4. Claims 1-4 and 9-12 have been amended.
5. No claims have been added.
6. Claims 1-24 are currently pending and have been examined.

#### **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-8 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular

machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

8. Claims 9-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 recite in the preamble "carrying one or more sequences..." is non-statutory because it is directed towards a signal per se "a carrier wave" lacking storage on a medium which enables any underlying functionality to occur. Therefore it does not fall in one of the statutory categories.

9. Claim 9 is rejected because claiming a software, program, instructions, code, or a data structure without any recitation of a proper computer readable medium is not statutory. To be

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statutory, examiner suggests reciting the claim as follows; one or more sequences of instructions stored in a computer readable medium executed by a processor or computer to perform... etc.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**13. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (US 5,708,828) in view of He et al. (US 2004/0039576).**

14. Regarding Claims 1-3 and 9-11: Coleman discloses a computer implemented method for managing inventory, the method comprising:

- Synchronizing inventory location information in a computerized inventory management system, wherein the computerized inventory location management system comprises a plurality of source computerized inventory management systems, and a plurality of target computerized inventory management systems, and the synchronizing comprises (abstract, figs.2B, 3, col1 lns 9-13):
- Extracting inventory location information in a source format, wherein the source format corresponds to a source computerized inventory management system, and the source computerized inventory management system is one of the plurality of source computerized inventory management systems (abstract, figs.2B, 3, col1 lns 9-13).
- Converting the inventory location information in the source format into inventory location information in an intermediate format (abstract, figs.2B, 3, col1 lns 9-13).
- Converting the inventory location information in the intermediate format into inventory location information in a target format, wherein the target format corresponds to a target computerized inventory management system, and the target computerized inventory management system is one of the plurality of target computerized inventory management systems (abstract, figs.2B, 3, col1 lns 9-13).

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Coleman does not explicitly teach synchronizing inventory location information, creating a new inventory location record in the target computerized inventory management system or updating an existing inventory location record in the target computerized inventory management system.

However, He et al. does disclose synchronizing inventory location information, creating a new inventory location record in the target computerized inventory management system or updating an existing inventory location record in the target computerized inventory management system (abstract, fig.4, paras 10, 11, 18, 20, 24, and claim 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use He et al's teachings in Coleman's "system for converting data from input data using first format to output data using second format" enabled, for the advantage of minimizing inventory management data conversions and to facilitate data exchanging between customers and suppliers in the automotive industry. Also, to improve work management efficiency and to cut down operating costs (He et al; para 4).

15. Regarding Claims 4 and 12: Coleman discloses a method of claim 1, wherein the intermediate format includes a list of inventory locations class with a hierarchy of data elements (abstract, figs.2B, 3, col1 lns 9-13).

16. Regarding Claims 5, 8, 13-19, 23, and 24: the combination of Coleman and He et al. disclose a method of claim 4, wherein the hierarchy of data elements includes a plurality of inventory location elements, wherein each of the plurality of inventory location elements includes: an identifier for identifying the inventory location element; a base data element for

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defining: a location description; a location name; and a location type code; a list of addresses element for defining a plurality of address elements from a party class; a list of related business units elements for defining a plurality of business units associated with the inventory, and wherein each of the plurality of business units associated with the inventory includes an identifier element; a list of related inventory locations for defining a plurality of related inventory locations; and a custom data element for defining customized attributes for the inventory (abstract, figs.2B, 3, col1 lns 9-13).

Coleman does not explicitly disclose inventory location elements.

However He et al. does disclose hierarchy of data elements includes a plurality of inventory location elements (abstract, fig.4, paras 10, 11, 18, 20, 24, and claim 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use He et al's teachings in Coleman's "system for converting data from input data using first format to output data using second format" enabled, for the advantage of minimizing inventory management data conversions and to facilitate data exchanging between customers and suppliers in the automotive industry. Also, to improve work management efficiency and to cut down operating costs (He et al; para 4).

17. Regarding Claims 6, 20, and 21: Coleman discloses a method of claim 5, wherein each of the plurality of address elements includes: an address identifier element; an address base data element, wherein the address data cleansing data element includes a disable cleansing flag element; an address data cleansing data element; an address relationship data element; and an address custom data element (abstract, figs.2B, 3, col1 lns 9-13).

18. Regarding Claims 7 and 22: Coleman discloses a method of claim 6, wherein the address relationship data element includes: an address effective end date element; an address occupancy type code element; an address effective start date element; an address type code element; and an address list of roles element (abstract, figs.2B, 3, col1 lns 9-13).

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/  
Examiner, Art Unit 3627  
August 1, 2009

/Ramsey Refai/  
Primary Examiner, Art Unit 3627